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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/609,123   | 06/27/2003  | Tushar Patel         | 101896-0178         | 6697             |
| 21125  | 7590        | 08/18/2006           | EXAMINER            |                  |
| NUTTER MCCLENNEN & FISH LLP<br>WORLD TRADE CENTER WEST<br>155 SEAPORT BOULEVARD<br>BOSTON, MA 02210-2604 |             |                      | COMSTOCK, DAVID C   |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             |                      | 3733                |                  |

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8P

|                              |                 |              |  |
|------------------------------|-----------------|--------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s) |  |
|                              | 10/609,123      | PATEL ET AL. |  |
|                              | Examiner        | Art Unit     |  |
|                              | David Comstock  | 3733         |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 08 June 2006.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-4 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 6-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The objection to the drawings has been withdrawn since the subject matter therein is not deemed to be inventive or require further illustration. Applicant's statement (Remarks, page 7) that "clamps and posts for mating a device to a support are well known in the art, and no person having ordinary skill in the art needs to see a drawing of a clamp or a post to understand the subject matter being claimed" has been noted.

### ***Specification***

The use of the trademark BOOKWALTER™ has been noted in this application (see paragraphs 0022, which has two instances and paragraph 0032, which has one instance). This trademark should be be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. No new matter should be added.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Florin (3,626,471).

Florin discloses a device 10 comprising an elongate member including a substantially planar surface 11 capable of retracting tissue and guide members 13, 14 having lumens 15, 16. The distal portion of the elongate member is wider than each guide member (see Fig. 1). The two lumens are oriented at an angle to one another. A mating cleat portion 17 extends beyond the end of the guide members. A rectangular cross member 23 is capable of serving as a connection point for connecting another retractor to the first, if desired. Elongate rod member 21, can also be considered to be a cross member.

Claims 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Oxland et al. (5,676,666; cited by applicant).

Oxland et al. disclose an elongate member 62 comprising planar retracting surfaces 72, 74, and removable guide members 80, 82 having lumens therewithin (see Fig. 1). The planar surfaces have a width that is greater than that of each guide. The lumens extend at an angle to one another. The device includes extension cleats 76 on a distal portion of the device, and the distal portion is disposed at an angle to the

proximal portion. The hinge of the device constitutes a cross member. The device attaches to a plate 10 having superior 36 and inferior 38 portions with holes 34 (see Figs. 2-8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oxland et al. (5,676,666; cited by applicant) in view of Kurland (4,686,972).

Oxland discloses the claimed invention except for the concave end portions. Kurland also discloses a drilling guide 10 and provides concave ends 6 to facilitate proper seating on the drilling target (see Figs. 1 and 2 and col. 1, lines 48-57, and abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Oxland et al. with a concave end portion, in view of Kurland, in order to facilitate proper seating on a drilling target and improve the procedure.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oxland et al. (5,676,666; cited by applicant).

Oxland discloses the claimed invention except for explicitly disclosing the angular range of about 110 to about 160, as between the proximal and distal portions of the

device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device within a range of 110 and 160 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It also would have been obvious to make portions of the plate slidably movable, since it has been held that the provision of adjustability involves only routine skill in the art, and it would be desirable to properly position and fix the plate. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

### ***Response to Arguments***

Applicant's arguments filed 08 June 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Florin is not intended to be used to retract the same type of tissue as that recited by Applicant, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.* It is noted that the device is capable of coupling to, i.e. at least joining with, a spinal implant; for example, as a lever or placement or removal means. It is noted that the structure need not be optimal, but rather, must at least merely possess the capability to satisfy the limitations of intended use as claimed. The structure of Oxland et al. likewise is at least capable of satisfying the claimed limitations. It is noted

that Kurland teaches providing an end portion that is congruent in shape to a target. Oxland et al. would not be inoperative for a curved plate, and in fact, would be better suited thereto. It is also noted that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art, i.e. making the end match the shape of a desired target.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

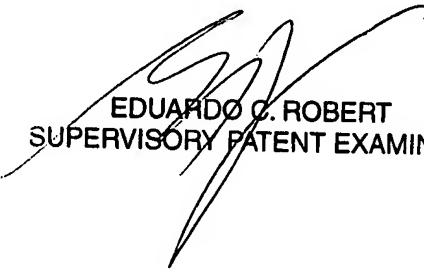
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER